

- Sub
Stockl
Canceled*
37. (Previously added) A floor covering according to claim 26, further comprising at least one of perforations provided between the first and second projections and recesses formed in the underside.
38. (Previously added) A floor covering according to claim 26, wherein at least one of the perforations and the recesses have one of a circular cross-section and a cross-section of a segment.
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REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, claim 1 has been amended to include the limitation of claim 35 and claim 35 has been canceled.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

The Examiner has rejected claims 26-29, 31-34 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Stockl, U.S. Patent No. 3,699,926 (Stockl). The Examiner has rejected claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Myrvold, U.S.

Patent No. 5,619,832 (Myrvold). The Examiner has rejected claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Dunl, U.S. Patent No. 4,329,981 (Dunl). The Examiner has rejected claim 24-24 under 35 U.S.C. § 103(a) as being unpatentable over Stockl in view of Dickens et al., U.S. Patent No. 4,478,901 (Dickens). It is respectfully submitted that claim 26, as amended, and claims 27-34 and 36-38 that depend therefrom, are patentable over the cited references.

In the Office Action, the Examiner argues that claim 26 (prior claim 35) is unpatentable over Stockl in view of Dunl. Applicants respectfully disagree. Dunl discloses a foot massage mat whose surface is in the form of naps. (See Fig. 3 and col. 5, lns. 5-7). The purpose of such naps is not for cushioning but for massaging the user's foot, as indicated by the Examiner, in the Office Action, at page 5, paragraph 4. In contradistinction, the patent application states, in the "Summary of Invention" section, at page 3, line 14 to page 4, line 3: "In this embodiment, the relative movement of the smaller spherical segment vis-à-vis the larger spherical segment produces an additional cushioning effect when loaded. Moreover, the more finely formed surface structure provides increased non-slip properties. These effects, can also be, further, obtained in other combinations of a larger and a smaller basic form so that embodiments

with basic geometric forms superimposed in this manner can generally be considered advantageous.”

It is respectfully submitted that a *prima facie* case of obviousness has not been made. Even if the cited prior art could be construed to disclose certain matter as contended by the Examiner, no disclosure or suggestion in any of the cited prior art can be found which should lead a skilled artisan to combine their various features to achieve the claimed invention. That separate features of different references may not properly be combined, in the absence of some specific teaching that they should or could be so combined, is such well-settled law that it hardly need be repeated here. See, e.g., In re Newell, 13 U.S.P.Q. 2d 1248, 1250 (Fed. Cir. 1989), citing Smithkline Diagnostis v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988). In order to reach the conclusion that the claimed subject matter as a whole would have been obvious, there must have been some teaching, suggestion, or inference in either reference, or both, which would have led one of ordinary skill to combine the relevant teaching of the references. ACS Hospital System, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). No such teaching, suggestion or inference could be found in any of the cited prior art.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

The In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”. The prior art must be viewed “without reading into that art Appellant’s teachings” and the teachings of the prior art should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obvious.” In re Spinnoble, 160 U.S.P.Q. 237, 243 (CPA 1969).

It is respectfully submitted that the teachings of the prior art does not make the present invention, as claimed in claim 26 obvious. Claims 27-34 and 36-38 depend on claim 26 and are allowable for the same reasons claim 26 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with features recited in Claim 26 are not disclosed or suggested in the prior art. Accordingly, Applicants respectfully request withdrawal of the obviousness rejection to such claims.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



Ronit Gillon

Reg. No. 39,202

Dated: June 25, 2003
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, N.Y. 10019
Tel.: (212) 839-7354

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, Alexandria, VA 22313-1450 on June 25, 2003.

